

REMARKS

Reconsideration of the present application, as amended, is respectfully requested.

Status of the Claims

Claims 1, 3-9, 11-13 and 15-16 are pending in the application, claims 1, 3-5, 7-9, 11, 12, 15 and 16 having been amended herein.

Claims 2, 10 and 14 have been cancelled without prejudice.

Claims 1-6 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 1-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Marchante in view of Gay et al..

Claims Rejections - 35 U.S.C. §112, Second Paragraph

Claims 1-6 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner stated that the term “corresponding substantially to the production width of the paper is reeled in a second reel-up” renders claim 1 indefinite.

Claim 1 has been amended herein to more clearly recite the invention and resolve the above described inconsistency. In view of the amendments to the claim 1 it is submitted that the Examiner’s objections to the claims and rejection of the claims under 35 U.S.C. §112, second paragraph have been overcome.

The Examiner also rejected claim 2 as being indefinite. Specifically, the Examiner asserts that claim 2 does not further limit the steps of claim 1. Claim 2 has been canceled without prejudice, thus rendering the Examiner’s rejection under 35 U.S.C. §112, second paragraph, moot.

Claims Rejections - 35 U.S.C. §103(a)

Claims 1-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Marchante in view of Gay et al.. Applicant respectfully traverses this statement.

The publication date of the Marchante reference is April 16, 2002. The present application is a §371 National Phase Application based upon PCT International Application PCT/FI99/00701 which has an International filing date of August 26, 1999. The filing date of a U.S. National Stage Application, as in the present case, is the international filing date. (*See* MPEP §1893.03(b)). Since the publication date of the Marchante reference, i.e. April 16, 2002, is not more than one year prior to the filing date of the present application, i.e. August 26, 1999, it does not qualify as a 102(b) type reference.

Since the Marchante reference does not qualify as a 102(b) type reference the Examiner might consider that the Marchante reference is a 102(e) type reference. (*See* MPEP 706.02). The Marchante reference has a 102(e) date of June 27, 2000 as indicated on the front of the patent. However, the PCT Application upon which the present application is based claims priority of Finnish Patent Application 981825 filed on August 26, 1998. A 102(e) type rejection may be overcome by perfecting a claim of priority under 35 U.S.C. §119(a)-(d). Since the foreign priority date, i.e. August 26, 1998, antedates the earliest filing date of the Marchante reference it is submitted that the reference cannot be relied upon by the Examiner as a valid reference.

In view of the foregoing it is submitted that the Marchante reference fails to meet the requirements of a reference that antedates the claimed invention.

Further in view of the above it is submitted that the teachings of Gay cannot be combined with the teachings of Marchante in any manner to thereby render the claimed invention obvious.

Conclusion

In view of the above amendments it is submitted that the Examiner's rejections have been overcome and should be removed and the present application should now be in condition for allowance.

Should any changes to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same.

It is believed that this communication is being timely submitted. However, in the event that it is untimely and extension fees are required, this is to be considered a petition for extension and the Commissioner is hereby authorized to charge any requisite fee to Deposit Account No. 50-0518.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

STEINBERG & RASKIN, P.C.

By: 

Paul J. Higgins
Reg. No. 44,152

Steinberg & Raskin, P.C.
1140 Avenue of the Americas
New York, New York 10036
(212) 768-3800